REMARKS

In the Office Action[1], the Examiner rejected claim 9 under 35 U.S.C. § 101;

rejected claims 1-16 under U.S.C. §102(e) as being anticipated by U.S. Patent No.

5,963,155 by Cheng et al. ("*Cheng*"); and rejected claims 17-21 and 23-28 under

35 U.S.C. § 103(a) as being unpatentable over *Cheng* in view of U.S. Patent No.

5,682,158 by Edberg et al. ("*Edberg*"). The Examiner also objected to claims 2-4 as

being of improper dependent form on a cancelled claim.

Applicant respectfully directs the Examiner's attention to the front page of the

continuation application, filed February 19, 2002, in which claims 2-16 were cancelled.

The rejection of claims 1-16 and the objection of claims 2-4 set forth in the Office Action

mailed October 6, 2005 are therefore moot.

The Examiner indicated that the four (4) non-patent documents included in

Applicant's IDS dated February 19, 2002 were not considered because they were not

submitted. The Examiner also did not initial document EP 0 800 142 A1. Applicant has

included copies of the four (4) non-patent documents as well as EP 0 800 142 A1 and

respectfully requests the Examiner consider these documents and annotate the PTO

1449 form accordingly in the next Office Action.

The Examiner did not indicate that the drawings, filed February 19, 2002, have

been accepted. Applicant respectfully requests the Examiner to consider the drawings

and indicate their status in the next Office Action.

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[1] The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicant declines to automatically subscribe to any statement or characterization in the Office Action.

By this Amendment, Applicant has amended the specification to correct a typographical error.

Applicant has amended claims 17, 20, 23, and 26 and cancelled claims 19, 22, 25, and 28 such that claims 17, 18, 20, 21, 23, 24, 26, and 27 remain pending in this application. Claims 17, 20, 23, and 26 have been amended to include the subject matter of claims 19, 22, 25, and 28 respectively.

I.   **Regarding the rejection of claims 17-21 and 23-28 under 35 U.S.C. § 103(a) as being unpatentable over *Cheng* in view of *Edberg***

Applicant respectfully requests that the Examiner reconsider and withdraw the rejection of claims 17-21 and 23-28 because a *prima facie* case of obviousness has not been established with respect to these claims[2].

> To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). M.P.E.P. § 2142, 8th Ed., Rev. 2 (May 2004), p. 2100-128.

A *prima facie* case of obviousness has not been established because, among other things, neither *Cheng* nor *Edberg*, taken alone or in combination, teach or suggest each and every element recited by Applicant's claims.

Claim 17 recites a combination including, for example:

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[2] In the Office Action, the Examiner did not indicate claim 22 as rejected. Applicant will assume that the Examiner intended to include claim 22 in the rejection under 35 U.S.C. § 103(a).

converting the fixed-byte format message into a multibyte format message including characters represented by various numbers of bytes, depending on the character; obtaining an actual length of the multibyte format message; <u>packaging the information reflecting the actual length of the multibyte format message with the multibyte format message</u>; and transmitting the packaged information and multibyte format message to a network node <u>in a HTTP request.</u>

(emphasis added). *Cheng* does not teach or suggest at least these elements. *Cheng* states that "it has become increasingly important that the computers connected to these networks [internet and computer], and their operating systems, be able to work with information represented in a variety of character sets" (column 1, lines 16-20). The Examiner admits that *Cheng* does not teach the use of a HTTP request (Office Action at page 7). The Examiner states that it would have been obvious to use HTTP because it was a well-known protocol for transmitting requests and responses over the internet (Office Action at page 7). Applicant disagrees. HTTP is one example of a data format suitable for communication in a network (Specification at page 12, lines 1-2). Other types of data formats are also suitable for communication in a network. The system in *Cheng* transforms information between UCS and EBCDIC-friendly representations (column 3, lines 6-8). There is no teaching in *Cheng* that this transformation will create a HTTP request.

Even if HTTP can be considered a well-known protocol, as the Examiner asserts, there is no teaching in *Cheng* of "packaging the information reflecting the actual length of the multibyte format message with the multibyte format message; and transmitting the information and the message to a network node in a HTTP request" as recited in claim 17.

Edberg does not cure the deficiencies of *Cheng*. *Edberg* teaches a truncation technique that "is particularly useful when the input source string is data received over a network" (column 3, lines 36-50). This technique ensures that a course string received for conversion is accurately converted into a different, target character encoding even when the source string exceeds the length of the input buffer (colum 3, lines 36-40). *Edberg* does not teach "packaging the information reflecting the actual length of the multibyte format message with the multibyte format message; and transmitting the information and the message to a network node in a HTTP request" as recited in claim 17.

The Examiner's application of "it was well-known" (Office Action, p. 7) to allegedly cure the failure of *Cheng* and *Edberg* to disclose "packaging the information reflecting the actual length of the multibyte format message with the multibyte format message; and transmitting information and the message to a network node in a HTTP request", fails to cure the deficiencies of *Cheng* and *Edberg*. The Examiner appears to be taking Official Notice by alleging "HTTP was a well-known protocol for transmitting requests and responses over the internet" (Office Action at page 7).

Even if this "well-known protocol" were combined with *Cheng* and *Edberg* as the Examiner suggests, *Cheng*, *Edberg*, and this "well known protocol" do not teach or suggest all the features of Applicant's claimed invention in independent claim 17.

Moreover, Applicant disputes the Examiner's presumed taking of Official Notice that "HTTP was a well-known protocol for transmitting requests and responses over the internet" (Office Action at page 7). Applicant respectfully directs the Examiner's attention to M.P.E.P. § 2144.03, regarding the "Procedure for Relying on Common

Knowledge or Taking Official Notice." In relevant part, the M.P.E.P. states, "If the examiner is relying on personal knowledge to support the finding of what is known in the art, the examiner must provide an affidavit or declaration setting forth specific factual statements and explanation to support the finding." M.P.E.P. § 2144.03(C). Applicant submits that the Examiner made a generalized statement regarding data format for communication, without any documentary evidence to support it, and attempted to apply this against Applicant's claim 17, with the only "support" being the highly subjective allegation that it "was well-known" (Office Action at page 7).

Furthermore, M.P.E.P. § 2144.03 sets forth that "the notice of facts beyond the record which may be taken by the examiner must be 'capable of such instant and unquestionable demonstration as to defy dispute.'" "It would not be appropriate for the examiner to take official notice of facts without citing a prior art reference where the facts asserted to be well-known are not capable of instant and unquestionable demonstration as being well-known." Id., internal citations omitted, emphasis in original.

Applicant therefore traverses the Examiner's reliance on conclusions which have not factually been made of record as being common knowledge, noting the impropriety of this action. As the Federal Circuit held in *In re Zurko*, 258 F.3d 1379, 59 U.S.P.Q.2d 1693 (Fed. Cir. 2001), an assessment of basic knowledge and common sense that is not based on any evidence in the record lacks substantial evidence support. Applicant respectfully points out that "[d]eficiencies of the cited references cannot be remedied by … general conclusions about what is "basic knowledge" or "common sense."" *In re Lee*, 277 F.3d 1338, 1344, 61 U.S.P.Q.2d 1430, 1432-1433 (Fed. Cir. 2002), quoting *In re Zurko*, 258 F.3d at 1385, 59 U.S.P.Q.2d at 1697 (Fed. Cir. 2001).

Should the Examiner maintain the 35 U.S.C. § 103(a) rejection after considering the arguments presented herein, Applicant respectfully submits that

> the basis for such reasoning must be set forth explicitly. The examiner must provide specific factual findings predicated on sound technical and scientific reasoning to support his or her conclusion of common knowledge. See *[In re Soli,* 317 F.2d 941, 137 U.S.P.Q. 797 (CCPA 1963)], 317 F.2d at 946, 37 USPQ at 801; *[In re Chevenard,* 139 F.2d 711, 60 U.S.P.Q. 239 (CCPA 1943)], 139 F.2d at 713, 60 USPQ at 241. The applicant should be presented with the explicit basis on which the examiner regards the matter as subject to official notice and be allowed to challenge the assertion in the next reply after the Office action in which the common knowledge statement was made. M.P.E.P. § 2144.03(B).

Therefore, the Examiner's application of *Cheng, Edberg,* and the "well-known protocol" does not satisfy the tenets of a proper 35 U.S.C. § 103(a) rejection. The rejection under 35 U.S.C. § 103(a) is therefore improper. Claim 18 depends from claim 17 and is thus also allowable over *Cheng* in view of *Edberg,* for at least the same reasons as claim 17.

Independent claims 20, 23, and 26, though of different scope from claim 17, recite limitations similar to those set forth above with respect to claim 17. Claims 20, 23, and 26 are therefore allowable for at least the reasons presented above. Claims 22, 25, and 28 are also allowable at least due to their dependence from claims 20, 23, and 26 respectively.

II. Conclusion

In view of the foregoing remarks, Applicant respectfully requests reconsideration of this application and the timely allowance of the pending claims.
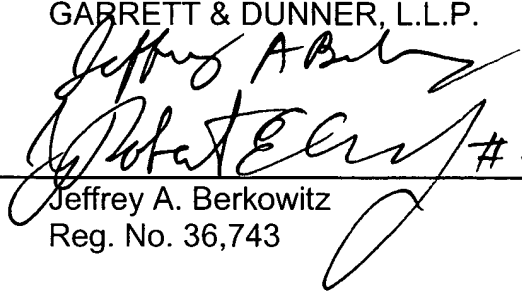
Please grant any extensions of time required to enter this response and charge

any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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Dated: December 21, 2005   By: _____ #27,432

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